

REMARKS

Reconsideration and further examination of this application is hereby requested. Claims 1-32 are currently pending in the application.

Claims 1-9, 11-28, and 30-32 have been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen (patent US 5987306) in view of Buchbinder (patent publication US 2002-0078198). Claim 10 has been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen in view of Buchbinder and further in view of Martin (patent US 6363419). Claim 29 has been rejected under 35 U.S.C. § 103(a) as being obvious over Nilsen in view of Buchbinder and further in view of Reeves (patent US 5918023). These rejections are respectfully traversed based on the following arguments.

A. Limitations Not Taught Or Suggested By The Prior Art

In order for a patent claim to be obvious, the prior art must teach or fairly suggest each and every limitation recited in the claim. That is because the claim must be considered as a whole; it may not be distilled down to a "gist."

The Patent Examiner acknowledges that the claims recite both a "test traffic modem" and a "control link modem", and that the prior art evidence (Nilsen and Buchbinder) does not show the separate modem structures, but only one modem. He then glosses

over this distinction between the prior art and the claim limitations by taking notice that it is well known to have a single structure perform two functions.

However, this conclusion misses the point: Applicant disclosed explicitly in the specification that there is a reason for having two modems instead of one. See specification at numbered para. 117. Briefly stated, this reason is: By having a modem for the control link that is diverse from the modem being used to send and receive test traffic, the commands for how to run the tests can be provided via a known robust network connection that is not subject to the vicissitudes of a potentially faulty network that is under test. It is this specifically identified structural advance that has been claimed.

The Patent Examiner's reasoning (that it is well known to have a single structure perform two functions, and thus obvious to do so) backfires because this reasoning is actually an argument for why NOT to configure the system the way Applicant has claimed it. If it truly were obvious to consolidate multiple functions in a single modem, then persons of ordinary skill in the art would have been led NOT to have made the device with two separate modems as has been claimed. The Examiner has not set forth a reason why a person having ordinary skill in the art would have used two modems instead of only one.

For the above reasons, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-32.

B. Prior Art Status Of The Buchbinder Reference Is Doubtful

Applicant respectfully challenges whether the Buchbinder reference (patent application publication no. US 2002-0078198) is prior art for the purpose it is being used for by the PTO. Buchbinder may not be valid evidence against the aspects of the claims against which it is being applied.

Applicant questions whether the WDP and WAP portions of the disclosure were present in the earlier application (appln. no. 09/513,550, filed Feb. 25, 2000) from which Buchbinder claims priority, or whether the WDP and WAP portions were added later when the Buchbinder application was filed Feb. 15, 2002. If the WDP and WAP stuff was added in the later filing, then Buchbinder is not valid evidence against the claims in the instant application. Accordingly, Applicant respectfully asks the Examiner to provide proof that the WDP and WAP stuff was in the earlier application from which Buchbinder claims priority. Applicant respectfully asks the PTO to provide a copy of the earlier application from which Buchbinder claims priority, since this relevant document has not thus far been made of record.

Since the Buchbinder reference is an essential evidentiary

element of all of the prior art rejections, Applicant respectfully submits that its doubtful status as prior art with respect to the claimed invention further shows that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-32.

C. Closing

For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-32. If there remain any issues that may be disposed of via a telephonic interview, the Examiner is kindly invited to contact the undersigned at the telephone number given below.

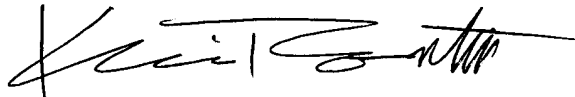
REQUEST FOR RECONSIDERATION
Appln. No. 09/899,955

PATENT APPLICATION

The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully submitted,

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